

REMARKS

This is responsive to the Non-Final Office Action mailed November 27, 2007. Claims 40-45, 47-56, and 58-67 are previously presented, and claims 1-39, 46, and 57 are canceled. Thus, claims 47-56 and 58-67 are pending in this application. No new matter has been added. Reconsideration is requested based on the remarks presented herein.

Summary of Interview with the Examiner on April 28, 2008:

The following is Applicants' summary of the Interview with the Examiner of April 29, 2008, and matter recited in the Examiner's Interview Summary form mailed May 12, 2008.

- 1) Application Serial No. 09/750,500
- 2) Applicant name: Epstein et al.
- 3) Date of interview: April 28, 2008.
- 4) Type: Telephonic.
- 5) Participants: 1) Leslie S. Garmaise (Reg. # 47,587), Applicants' representative;
2) Examiner Hussein A. El Chanti.
- 6) No exhibit was shown.
- 7) Prior Art: The participants discussed the prior art reference U.S. Patent No. 6,557,169 by Erpeldinger (referred to hereafter as Erpeldinger).
- 8) Issues Discussed:

First, the Applicants' representative and the Examiner agreed that the Office Action mailed November 27, 2007 was Non-Final, and that the initial indication of Finality on the Office Action Summary sheet was incorrect. The Examiner indicated that the status of the application in the USPTO's internal system was adjusted so as to be considered under Non-Final rejection.

With regard to the merits, most of the discussion centered on the limitations of claim 40. Attention was directed in particular to the first paragraph of claim 40. Applicants contended that Erpeldinger did not disclose the features recited in the first paragraph of claim 1. Moreover,

Applicants noted that the sole system diagram of Erpeldinger in Figure 1 thereof, did not illustrate any network or computer connection meeting the limitations recited in the first paragraph of claim 1.

The Examiner contended that the passage at column 1, lines 22-32 of the Background section of Erpeldinger met the limitations of the first paragraph of claim 1. The Examiner contended that the description of Figure 1 in the “Detailed Description” portion of Erpeldinger met the limitations of the second paragraph of claim 1.

8) The Examiner and Applicants’ representative did not reach agreement regarding the patentability of the independent claims in light of Erpeldinger. The Examiner left a voice mail for Applicant on May 4, 2008 indicating that after reviewing Erpeldinger and the claims again, after the interview of April 28 2008, the Examiner had not changed his position.

Rejection under 35 U.S.C. § 102:

Claims 40-45, 47-56, and 58-67 are rejected under 35 U.S.C. § 102(e) as being anticipated by Erpeldinger (U.S. Patent No. 6,557,169, hereafter, Erpeldinger). “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Moreover, “the elements must be arranged as required by the claim . . .”. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Applicants contend that Erpeldinger does not identically disclose the subject matter of Applicants’ claims. Further, Erpeldinger does not even suggest arranging the claimed elements as recited in Applicants’ claims. Accordingly, Applicants respectfully traverse the outstanding rejection.

In the following, Applicants provide an introduction to the novel features of the claimed invention, then address the Office Action’s proposed combination of features drawn from the “Description of the Related Art” and of the inventive embodiment of Erpeldinger. Thereafter, Applicants address the specific limitations of claim 40 and of selected dependent claims in light of the prior art.

Importantly, and with reference to Figure 2 of the present application, the present invention uses two different sets of servers, each of which sets establishes a different security relationship with the client computers. Specifically, one set of servers securely accesses the client computers without permitting the client computers to securely access the servers. The other set of servers ***is securely accessed by*** the same client computers without permitting the servers to securely access those client computers. Thus, while two sets of servers provide services to the client computers, the trust relationship of the first set of servers to the client computers is opposite the direction of the trust relationship between the second set of servers and the client computers. Applicants contend that Erpeldinger does not disclose any such arrangement.

Improper Combination of The Embodiments:

To identify disclosure of the first paragraph of claim 40 by Erpeldinger, the Office Action cites to col. 1, lines 22-32, which forms part of the Description of the Related Art. To identify disclosure of the second paragraph of claim 40 by Erpeldinger, the Office Action cites to col. 2, line 65- to col. 3, line 22 (as the cite is best understood), which describes a different embodiment. The second cited section above includes the “Summary of the Invention” and the “Detailed Description of The Invention” of Erpeldinger.

Applicants contend that it is improper to combine the two separate embodiments in this manner to attempt to meet the limitations of claims 40 and 51, based on the case law cited below. It is improper to combine different embodiments within a single reference for purposes of anticipation, unless the reference teaches or suggests the combination. *Applera Corp., MDS Inc. v. Micromass UK Ltd.* 204 F.Supp.2d 724, 752 (D. Del. 2002). (“Only if the French application teaches or suggests the combining of different embodiments to one of skill in the art, should the fact finder do so for purposes of anticipation.”).

In this case Erpeldinger specifically teaches away from any such combination. Specifically, Erpeldinger criticizes the embodiment described in the Background section thereof, reciting “the prior art systems have [an] undesirable limitation and disadvantage.” See Erpeldinger, col. 2, lines 3-4 (emphasis added).

Accordingly, it is submitted that to anticipate Applicants’ claims, the Examiner must identify a single embodiment that meets the limitations of Applicants’ claims and which is *arranged as claimed by Applicants’ claims*, (See *In Re Bond* 910 F.2d 831, 832 (Fed. Cir. 1990)

(emphasis added). Applicants respectfully contend that no single embodiment in Erpeldinger does this.

Having shown the impropriety of combining the embodiments of Erpeldinger above, Applicants separately contend that no combination of embodiments of Erpeldinger meets the limitations of Applicants' claims. Attention is directed to claim 40.

Claim 40 recites the limitations:

- (1) providing a first set of services on a first set of one or more servers of the service provider to the plurality of client computers by providing secure access to the first set of one or more servers by the plurality of client computers, but prohibiting secure access to the plurality of client computers by the first set of one or more servers; and
- (2) providing a second set of services on a second set of one or more servers of the service provider to the plurality of client computers by providing secure access to the plurality of client computers by the second set of one or more servers, but prohibiting secure access to the second set of one or more servers by the plurality of client computers.” (Paragraph numbers added).

Independent claims 51, 62, and 66 recite related limitations. Erpeldinger fails to disclose most of the above limitations.

Attention is directed first to paragraph (1) above. The Examiner purports to supply the limitations of paragraph (1) above from col. 1, lines 22-32 of Erpeldinger (see OA, page 2, paragraph 2, lines 8-9). The cited section of Erpeldinger provides a general introduction to the section labeled the “description of the related art” of Erpeldinger. The most pertinent section Applicants can identify in the cited passage recites that “a user may connect to several servers to use different services.” Col. 1, lines 31-32. However, the cited passage, like the rest of Erpeldinger, is completely silent with respect to “providing secure access to the first set of one or more servers by the plurality of client computers” and “prohibiting secure access to the plurality of client computers by the first set of one or more servers” which are recited in paragraph (1) of claim 40. Accordingly, the above-quoted limitations of paragraph (1) of claim 40 are not disclosed in Erpeldinger.

The Office Action cites to the passage between col. 2, line 65 and col. 3, line 22 of Erpeldinger as disclosing the limitations of paragraph (2) of claim 40. Erpeldinger describes a server 24 that is

coupled to a plurality of workstations and that is operable to transfer application software, including a new operating system to one of the workstations, such as workstation 12, in the pertinent network. See col. 2 lines 59-65. This passage and the succeeding passage between col. 2, lines 65 and col. 3, line 22, suggest that server 24 is able to securely access workstation 12. However, nowhere do these passages disclose “prohibiting secure access to the . . . client computers by the first set of one or more servers” which is recited in paragraph (2) of claim 40. Accordingly, the cited passage of Erpeldinger does not disclose the limitations of paragraph (2) of claim 40, as alleged in the Office Action.

Based on the foregoing, Erpeldinger does not disclose all the limitations of claim 40 or of the other independent claims. Claims 40, 51, 62, and 66 are therefore patentable over Erpeldinger under 35 U.S.C. § 102 (e). The dependent claims are patentable over Erpeldinger by virtue of their dependency on their respective independent claims. A selection of the dependent claims are discussed below.

Claim 45 recites the limitation “preventing any said client computer from securely accessing resources in any other said client computer.” Claims 56 and 63 recite similar limitations. The Office Action contends that Erpeldinger discloses this limitation in the passage between col. 2, line 65 and col. 3, line 22 (see OA, page 3, lines 15-18). For the sake of this discussion, the client computers of Applicants’ claims are treated as being analogous to the “workstations” of Erpeldinger. It is believed that the Office Action drew this analogy as well. The workstations 12, 14, 16, 18 of Erpeldinger are shown in Figure 1 thereof, and listed at col. 2, line 57.

As stated above in connection with the rejection of claim 40, which is rejected over the same passage of Erpeldinger, the cited passage describes the transfer of software from server 24 to workstation 12. The cited passage is completely silent with respect to preventing any client computer/workstation from accessing any other workstation. Moreover, Applicant notes that the cited passage is directed exclusively to interaction between workstation 12 and server 24. Indeed, the other workstations 14, 16, 18 of the system of Figure 2 of Erpeldinger are not mentioned at all in the cited passage. Accordingly, Erpeldinger does not disclose the limitations of claims 45, 56, and 63. Applicants respectfully request, if this rejection is maintained, that the Examiner point with specificity to the portion of Erpeldinger that is alleged to disclose the limitations of claims 45, 56, and 63.

Conclusion:

Applicants respectfully request reconsideration and allowance in view of the above remarks and amendments. The Examiner is authorized to deduct any additional fees believed due from our Deposit Account No. 11-0223.

Respectfully submitted,

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